APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/924,785	09/05/1997	RICHARD W. PRATT	785	4422

7590 04/21/2004	EXAMINER
DAVID B. RITCHIE - THEIEN REID & PRIEST LLP	PRIETO, BEATRIZ

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ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application 08/924,785	Applicant(s) PRATT, RICHARD W.
	Examiner B. Prieto	Art Unit 2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _26 January 2004_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _44 and 62-74_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _44, and 62-74_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This communication is in response to amendment filed 02/24/03. Claims 1-43, and 45-61 have been canceled. Claims 62-74 have been added. Claims 44, and 62-74 remain pending and have been examined.

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   Claim 65-66 contains the trademark/trade name Java^{TM} class and ActiveX^{TM}. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe Java^{TM} class and ActiveX^{TM} , accordingly, the identification/description is indefinite.

4.   Quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this office action may be found in previous office action.

5.   Claims 44, and 47-60 are rejected under 35 U.S.C. §103(a) as being unpatentable over Madany U.S. Patent No. 5,922,050 in view of Beard U.S. Patent No. 5,875,335 in further view of Nakagawa et. al. (Nakagawa) U.S. Patent No. 5,835,911.

Regarding claim 44, a method comprising:

        obtaining a ("new downloadable unit") program (Madany: col 8/lines 4-41, col 1/lines 60-col 2/line 3) for performing a function ("new service") (Madany: col 5/lines 44-49), the program including

        a component ("communicator component") for establishing a communication across communication channel (14) between the client device (10) and the software program (Madany: col 4/lines 19-31, col 5/lines 31-43) included in the network device;

a component ("interface component") for enabling the client device to communicate with software program within the network device (Madany: col 5/lines 31-43, col 4/line 24-28);

a component ("configuration") for controlling (managing) the network device (Madany: col 4/lines 41-48 and col 7/lines 56-58); however Madany does not explicitly teach a program contained (embedded) in a compiled software program file, and retrieving the embedded program from the compiled software program file;

Beard teaches a remote client device (12) receiving a program (e.g. applet) from a server (10) over the network (18) (col 3/lines 46-67);

a program or method ("the downloadable unit") is embedded in the compiled (binary) file of the operating system (software program), i.e. functions or methods within (embedded) the compiled code (i.e. binary form) of the operating system file (26) (software program), such as function services (library) are contained in a compiled code of the operating system program file (col 2/lines 28-32), these are identified by a particular package of classes (downloadable unit) (col 2/lines 56-63); wherein the libraries to be extracted for a class are embedded in the package for the class (col 5/lines 66-col 6/line 1);

retrieving the embedded downloadable unit from the binary file, i.e. the functions library services (programs) within (embedded) the compiled code (i.e. binary form) of the operating system file (26) (software program) (col 2/lines 28-32), must be loaded into working memory (i.e. extracted) in order for an application program to employ the services provided by the library using techniques that are specific to the compiled code in which the library exists, i.e. is embedded (col 2/lines 63-67);

It would have been obvious to one ordinary skilled in the art at the time the invention was made to include a program(s) contained (embedded) in a compiled software program file, transferable over the Internet including means for extracting the embedded program from the compiled software program file to be used by an application, wherein the programs are configured as downloadable units, applets or embedded package of classes embedded in the compiled code of the operating system file, as taught by Beard, motivation to combine these teachings to configure embedded downloadable units, class packages or applets with dynamic linked libraries containing all information necessary to configure or define, control and communicate remotely with any device containing hardware/software resource; however neither the teachings of Madany nor Beard teach the substitution of program onto a network device;

Nakagawa teaches a system/method related to software distribution/maintenance with which a software distributors can provide and update for a number of users software/services over a network, for systematically distributed/maintained, re-installing and upgrading via a network connecting many distributor and users of client/server software, wherein a client program automatically updates the software to the latest version according to the update instruction information when it is received

(Nakagawa: col 1/line 13-col 5/line 10, abstract), disclosing means for retrieving the network device control software program binary file having an embedded old downloadable unit for performing an old service from a network device (Nakagawa: col 22/lines 3562);

It would be obvious to one ordinary skilled in the art at the time the invention was made to modify exist system with means for retrieving the network device control software program binary file having an embedded old downloadable unit for performing an old service from a network device, as taught by Nakagawa, motivation would be to further enhance existing means for adding, upgrading services to include a software distribution and maintenance means obtainable over a network for other various types of software such as product software, shareware, embedded software, freeware, scientific prototype software, intra-office software, etc, in an immediately operable form.

Regarding claim 62, this claim is the computer readable medium having stored thereon computer readable instructions for performing the method claim discussed above, same rationale of rejection is applicable.

Regarding claim 63, this claim is the computer-readable medium having stored thereon computer-executable instructions for performing the method disclosed on claim 44, same rationale of rejection is applicable.

Regarding claim 64, the network device includes a router (Madany: col 3/lines 41-43).

Regarding claim 65, downloadable unit includes a software unit (Beard: col 2/lines 55-67).

Regarding claim 66, downloadable unit includes software (Beard: col 2/lines 55-67).

Regarding claim 67, downloadable unit includes more than one unit (Beard: col 2/lines 56-67).

Regarding claim 68, downloadable units are combined into bundles (Beard: col 5/lines 66-col 6/line 4, and col 5/lines 21-30).

Regarding claim 69, downloadable units are combined into bundles according to a function (Beard: col 2/lines 56-67).

Regarding claim 70, downloadable units are combined into bundles according to a version information (Beard: col 2/lines 56-67).

Regarding claim 71, the program includes an operating system (Beard: col 4/lines 57-col 5/line 5).

Regarding claim 72, network device includes a router (Madany: col 3/lines 41-43).

Regarding claim 73, the program includes services ("list of available management services") (Beard: col 4/lines 57-col 5/line 5).

Regarding claim 74, downloadable unit include services (Beard: col 4/lines 57-col 5/line 5).

Response to arguments

7.   Applicant argues prior art does not teach how a computer would operate as a device or both, wherein the inclusion of a computer in applicant's opinion appears to be unusual as it is out of place with the other devices described.

In response to the above-mentioned argument, applicant opinions that generally devices and computer are described independently from one another, that a computer presented as a device is unusual and that Madany's disclosure is essentially one word long, are noted. Further, applicant's notes that the term computer in the Madany reference provides not indication as to what hardware and software it might include. Madany, according to applicant fails to discuss how a computer would operate as a device, one cannot assume that the computer in the Madany reference operated differently that the other devices listed, it is noted that the features upon which applicant relies (i.e., "how a computer would operate as a device or both", a "a device is not a computer" or "a computer is not a device", "devices and computers are independent from one another", and "a computer does not operate differently than a device") are not recited in the rejected claim(s).   Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993) (see MPEP 2111). Applicant's argument that teach prior art fails to teach the invention was claimed, specifically, how a computer would operate as a device or both to teach claim limitation are not persuasive. Claims do not recite a device that is not a computer, nor a computer that is not a device, nor claims recite how a computer would operate as a device.

8.   Applicant argues Madany does not disclose how his network control hardware is to be integrated in the existing device, because the portions of Madany, i.e. column 3, line 41-column 4/line 42 are characterized by the applicant as a discussion of the hardware of the device which fails to disclose how the integration is performed.

In response to the above, it is noted that the features upon which applicant relies (i.e., how hardware is integrated into the existing device", "replacing the existing original dedicated hardware", where "the existing device have hardware performs original dedicated functions", "unable to execute said program code, wherein hardware is not inexpensive nor low power, and excluding a whole range of hardware", and where "the invention is distinguishable from the prior art in which and applet cannot run") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The portions of the Madany reference, which applicant refers to discuss software aspects as well as hardware. Madany discloses in said portion, e.g. a communication program for communicating with the network, a program for interfacing with devices, logic for controlling features of the device, an I/O control program and an applet for controlling and communicating with the device (column 3, lines 41-col 4/line 33). This is not hardware nor can be characterized as "network control hardware" as set forth by applicant. Arguments that Madany fails to teach how disclosed "network control hardware" is to be integrated in the existing device are not with the scope of the claim language.

9.   Applicant's arguments filed 1/26/04 have been fully considered but not rendered persuasive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to the Central Fax Office:

(703) 872-9306, for Official communications and entry;

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal

Drive, Arlington VA, Fourth Floor (Receptionist), further ensuring that a receipt is provided stamped "TC 2100".

B. Prieto
TC 2100
Patent Examiner
April 19, 2004